



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/354,608	07/16/1999	YASUHIRO YAMANAKA	SONYJP-3.0-0	5368

530 7590 07/05/2002

LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK  
600 SOUTH AVENUE WEST  
WESTFIELD, NJ 07090

EXAMINER

HUSEMAN, MARIANNE

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 07/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/354,608

Applicant(s)

YAMANAKA, YASUHIRO

Examiner

Marianne Huseman

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 4/12/02 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 4/12/02 have been fully considered but they are not persuasive. Applicant's clarifications regarding the previous 35 USC § 112 are appreciated. However, there is still lacking an adequate disclosure for those phrases; see paragraph 3, below. Regarding Applicant's arguments that "Stefik neither discloses nor suggests such a copyright management means" is understood, however, the limitations to which Applicant refers are not contained within the claim. Regarding the reference Sprague: Sprague was used merely because satellite broadcast communication in an environment similar to Stefik (copyright distribution) is taught.

### *Status of Claims*

Claims 1 – 51 are pending; claims 28 – 51 have been added.

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 6, it is not clear as to what is meant by "pays a receiving fee...in units of the contents" (emphasis added). This also applies to claim 10.

In claim 1, line 9, it is not clear as to what is meant by "the copyright of a plurality of contents" (emphasis added). This also applies to claim 10.

In claim 1, lines 11 - 14, it is not clear as to what is being claimed; i.e., "receiving means for receiving..., sent from the receiving side, for specifying the contents... and received by the receiving side"; i.e., perhaps the phrase - -transmitted to- - or other similar phrase could be used instead of "received by"? The amount of use of the term receive makes the claim language confusing. This also applies to the last line of claim 1.

In claim 1, line 16, it is not clear as to what is meant by "each contents". Perhaps "contents" should be singular or - - of the - - should be inserted after "each". This also

BEST AVAILABLE COPY

Art Unit: 3621

applies to claim 2, lines 5 and 8. Applicants' are respectfully requested to review all of the claims and make the appropriate corrections.

In claims 1-27, there is no description in the specification, other than a repeat of the claims, of "received-contents-specifying information", "contents-identifying information" nor "distribution-service-identifying information".

In claim 28, it is not clear as to what is meant by "indicia"; i.e., there is no disclosure for the term "indicia". The term indicia, as defined in the *Miriam Webster's Collegiate Dictionary, 10<sup>th</sup> Edition*, means "distinctive marks" or "postal markings often imprinted on mail or on labels to be affixed to mail". See MPEP §706.03d.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4 – 7, 9, 10, 13 – 16, 18, 19, 22 – 25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik.

Regarding claims 1, 10 and 19:

Stefik, figure 1, discloses a data distribution system comprising:

- a distribution side, repository 1;
- a receiving side, repository 2;
- copyright information storage means, element 102, column 7, lines 19 - 21;

and

◦ receiving means for receiving received-contents-specifying information and copyright management means, element 105, column 7, lines 34 – 41.

Regarding claims 4, 5, 13, 14, 22 and 23: Stefik discloses:

- a customer management center, element 108.

Regarding claims 6, 15 and 24: Stefik discloses:

- receiving customer information, column 29, lines 44 - 58.

Art Unit: 3621

Regarding claims 7, 16 and 25: Stefik discloses:

- encrypting the content, columns 26 and 27, lines 62 – 67 and 1 – 31, respectively.

Regarding claims 9, 18 and 27: Stefik discloses:

- digital works that may be audio recordings, column 6, lines 50 – 53.

4. Claims 28 - 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Iida.

Regarding claims 28, 29, 40 and 41:

Applicant's server reads on element 22, Applicant's receiving facility reads on element 10, Applicant's indicia reads on elements 13 and 25, Applicant's memory reads on element 27 and Applicant's processor reads on column 15, lines 54 – 59 and figure 59 and its corresponding description.

Regarding claims 30 and 42:

Applicant's satellite broadcasting system reads on column 18, lines 4 – 9.

Regarding claims 31, 35, 39, 43, 47 and 51:

Applicant's copyright fee ratio reads on the description of figure 59.

Regarding claims 32 – 34 and 44 - 46:

Applicant's television program reads on column 6, lines 50 – 54.

Regarding claims 36 and 48:

Applicant's customer management system reads on element 13:

Regarding claims 37 and 49:

Applicant's musical works reads on element 23.

Regarding claims 38 and 50:

Applicant's step of downloading reads on element 40.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 3, 11, 12, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik.

While Stefik does not specifically disclose more than one database, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to make the files disclosed, a contents file and a description tree file (Applicants' program identification-information database and copyright information, respectively), column 9, lines 33 – 44, separate databases as creating databases would make it easier for the distributor to organize and locate content and creating databases is considered to be old and well known.

6. Claims 8, 17 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik in view of Sprague et al.

While Stefik does not specifically disclose using a satellite broadcasting transmission path, Sprague et al. teach an information distribution system, wherein digital data, encrypted, is transmitted via satellite broadcast. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art to utilize a satellite broadcast transmission path, as taught by Sprague et al. in order to take advantage of one more mechanism for distributing information to users.

#### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne Huseman whose telephone number is 703-605-4277. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

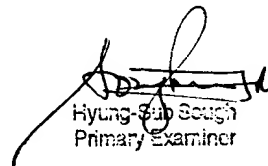
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Marianne Huseman  
Examiner  
Art Unit 3621

mh  
July 1, 2002



Hyung-Sup Seough  
Primary Examiner